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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/604,001	06/26/2000	Peter Hossel	50105	2632

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EXAMINER	
FUBARA, BLESSING M	
ART UNIT	PAPER NUMBER

1615

DATE MAILED: 04/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/604,001

Applicant(s)

HOSSEL ET AL.

Examiner

Blessing M. Fubara

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Examiner acknowledges applicants' remarks, request for reconsideration and notice of appeal, all filed 02/23/05.

Claim Rejections - 35 USC § 112

1. The rejection of claims 14 and 15 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is withdrawn in view of applicants' persuasive explanation.

Claim Rejections - 35 USC § 103

2. Claims 1-15 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Uhl et al. (US 5,219,969).

Applicants argue monomer (c) of the instant claims is not more than 40% while Uhl while Uhl requires the acid to be present at 50-99 parts by weight. Applicants have issue with Examiner's statement that "differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating the concentration is critical, it is not inventive to discover optimum workable amounts by routine experimentation" and that since the instant claims require the unsaturated anhydride to be not more than 40% by weight, the unsaturated anhydride of the instant claims is not encompassed by the disclosure of Uhl. Applicants contend that the question should have been whether a person of ordinary skill in the art would have been motivated to reduce the amount of acid monomer from 50-99 parts by weight as disclosed by Uhl to an amount of less than 40% as required by the claims and that such a

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change would not be a mere optimization according to Examiner's statement.

Applicants further state that there is no motivation to change the amounts of the particular constituent of Uhl from 50-99 parts by weight to not more than 40% because a particular parameter must first be recognized to be "result-effective variable" before optimum or workable ranges is sought.

3. Applicants' arguments filed 02/23/05 have been fully considered but they are not persuasive.

The instant claims require 0-40% by weight of unsaturated acid or unsaturated anhydride and Uhl as admitted by applicants in the remarks disclose 50-99 parts by weight of unsaturated acid. Applicants failed to recite any specific unsaturated acid and the unsaturated acid in claim is encompassed by the disclosed unsaturated acid of the prior art. It is not the amount that is encompassed by the monomer itself. The difference is in amounts and generally differences will not support the patentability in the absence of a showing that such a concentration is critical (in re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955)). Applicants failed to provide a demonstration that such percent amount is critical. Now, when the total weight is taken as 100g, then the 50-99 parts by weight is 50-99%. 0-40% (c) as required by the claim 1 means that (c) does not have to be present and that when present, the amount is not more than 40%. The issue is not a result-effective variable, which can be optimized, but optimization within the prior art conditions or through routine experimentation. The burden is on applicant to show that unsaturated acid in amount of not more than 40% is critical over the higher amount of the prior art.

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4. Claims 1-15 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Tropsch et al. (US 5,869,032).

Applicants state that Tropsch is prior art under 35 USC 12 (e), 102 (a) and 103 (b) and not just only 102(e). Applicants state that the C1-C12 alkyl esters and the alkyethylene glycol (meth) acrylates having 1-50 ethylene glycol units disclosed/mentioned in Tropsch fail to meet applicants' monomer (e). Applicants state that the obviousness type double patenting rejection should be withdrawn in light of the argument.

5. Applicants' arguments filed 02/23/05 have been fully considered but they are not persuasive.

Alkyl ethylene has a double bond and methacrylate also has a double bond, and these double bonds are not conjugated. Examiner thanks applicants for showing that Tropsch is art under 35 USC 102(e), 102 (a) and 103(b).

Double Patenting

6. Claims 1-15 remain rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 5,869,032.

As stated above, applicants argument with respect to US 5,869,031 has been considered but found unpersuasive according to the reasons above.

No Claim is allowed.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blessing M. Fubara whose telephone number is (571) 272-0594. The examiner can normally be reached on 7 a.m. to 3:30 p.m. (Monday to Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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